

disagrees with the Examining Attorney's position that it would be obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to arrive at the present invention and respectfully submits that the Examining Attorney did not give proper weight to the declarations previously submitted which clearly establish that it was not obvious to those who are skilled in the art.

Initially, the cited references fail to disclose or suggest some reason why the method steps or structure of the present invention would be obvious in light of their teachings.

While the Court in KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007) rejected a rigid application of the teaching, suggestion, or motivation ("TSM") test in an obviousness inquiry, the Court acknowledged the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" in an obviousness determination. KSR, 127 S. Ct. at 1731. Moreover, the Court indicated that there is "no necessary inconsistency between the idea underlying the TSM test and the Graham analysis." Id. As long as the test is not applied as a "rigid and mandatory" formula, that test can provide "helpful insight" to an obviousness inquiry. Id.

Takeda Chemical Industries Ltd. v. Alphapharm Pty. Ltd., 83 U.S.P.Q.2d 1169, 1174 (Fed. Cir. 2007)(emphasis added).

Thus even after KSR, it remains necessary to identify some reason that would have led one skilled in the art to modify the prior art in a particular manner to establish prima facie obviousness of a new claimed invention. Id. There is no reason that it would be obvious to one skilled in the art to combine Rowe with Evans or further with

Carlesimo to arrive at the present invention. This is supported by the previously submitted declarations and arguments.

The Office Action sets out in ¶3 the Examiner's interpretation of the teachings of Rowe. Specifically, it states that the planar flange 28 in Rowe has a first surface configured to seal the chamber wall around substantially the whole circumference of the opening. However, the surface of flange 28 never comes in contact with the chamber wall and any sealing in Rowe which does take place, is a result of the rubbery gaskets 14, 16 (Col 3, line 49). The presence of these rubbery gaskets in Rowe is stated to be a fundamental and essential element of Rowe's fitting for the following reasons:

(i) At column 1, line 48 to 68 inclusive, Rowe sets out explicitly and without reservation, that welding the fuel line or the entrance fitting to the chamber wall is to be avoided; and

(ii) Rowe also sets out some of the reasons why this arrangement is unsatisfactory. As previously discussed in the Amendment in Response to Office Action of November 15, 2007, Rowe (Col. 1, lines 51-54) states:

"Rigidly welding the entrance fitting to the chamber wall is not an ideal arrangement since ground shifting often occurs which could rupture the weld or the pipe." [Emphasis added]

This was certainly the perceived wisdom in the industry before the present invention was conceived. While Rowe does not set out all of the reasons as to why

welded joints should be avoided, the teaching of Rowe is clear. When attaching a fitting to the wall of a chamber, flexible rubbery gaskets are required between the flange(s) and the wall of the chamber, the gaskets being on opposite sides of the wall. These gaskets allow for the inevitable shifting in the ground surrounding the chamber. Thus, when Rowe seeks to improve on the prior art fittings, he not only steers completely clear of electrofusion, but retains these two gaskets and includes other components made of flexible, strong, resilient materials, namely reducer boots 22 and 24.

Clearly, Rowe knows of the technique of rigidly welding fittings to chamber walls since he refers to this technique at column 1, line 52 and Rowe himself clearly rejects this as a technique not worth pursuing! Instead, Rowe designs an eleven component part fitting (see exploded figure 1). It is clear that Rowe clearly considers the potential problem of weld rupture as such a significant problem that he dismisses the teachings of Evans and instead chooses a much more complex and expensive arrangement of designing an additional extra seal for a leak testable bulkhead around the conventional gasket seal arrangement. This in itself illustrates a widely held prejudice by those working in this technical field against welding a fitting directly to a chamber wall as presently claimed. The inventors in this application have dispelled the misconception previously held in the industry.

The fitting in Rowe contrasts starkly with the one piece fitting of the present invention. If it was obvious to apply the teaching of Evans, published well before

Rowe, to the prior art knowledge known to Rowe, then surely Rowe would have done this himself. But it was not obvious because of the common and widespread misconception that welded joints would inevitably fail over time due to the fact that such a fitting makes no allowance for shifting or angling of the pipe in the ground surrounding the chamber.

Therefore, not only is there no reason provided to combine Rowe and Evans, but common sense directs an inventor, like Rowe, to find a different solution. The results of using welding were predictable, and the prediction was that a welded joint would fail over time.

Support that it was not obvious to those who are of skill in the art to combine the cited references to arrive at the present invention is found in the previously submitted declarations of James Thompson, John Boudry and Andrea Ticci. Applicant respectfully submits that the Examiner did not give proper weight to these declarations which provide objective evidence of non-obviousness.

It is important to note that the prior art cannot be evaluated in isolation, but must be considered in light of the secondary considerations bearing on obviousness. Alco Standard Corp. v. Tennessee Valley Auth., 1 USPQ.2d 1337 (Fed. Cir. 1986). Objective evidence of non-obviousness must always be taken into account and not just when the decision maker is in doubt, See Hybritech Inc. v. Monoclonal Antibodies Inc., 231 USPQ 81 (Fed. Cir. 1986), as the significance of a new structure is often better measured in the marketplace than in the courtroom. See Continental Can Co. v.

Monsanto Co., 20 USPQ.2d, 1746 (Fed. Cir. 1991). Therefore, objective evidence of non-obviousness may be the most pertinent, probative and revealing evidence available to the decision maker in reaching its conclusion. See Ashland Oil Inc. v. Delta Resins & Refracs. Inc., 227 USPQ 657 (Fed. Cir. 1985).

As previously discussed by the Applicant in the prior Office Action replies, Thompson specifically discusses the problems associated with conventional underground polyethylene piping systems and why no one had used the fusion welding system for entry fittings for use in the petroleum industry prior to the current invention. (See Thompson Decl. ¶'s 3-5). Thompson also discussed the teachings and shortcomings of Rowe and why Rowe teaches away from the current invention, (e.g., ¶10-14). Similarly, the Declaration of John Boudry as previously discussed also addresses Rowe and why it does not suggest the presently claimed invention. (See ¶'s 4-11).

Dr. Ticci in his declaration also stated that one skilled in the art would consider the proposed combinations of the teachings of Rowe and Evans to be misdirected, and, in fact, those in the industry at the time of the invention would consider such a move to be destined to fail (¶8). Dr. Ticci also refers to other misconceptions in the industry which would direct one skilled in the art away from considering any type of electrofusion in a fitting such as those described by Rowe (¶9). In particular, Dr. Ticci refers to the fact that there was a widely held misconception in the industry that it would not be possible to form a strong durable electrofusion seal between a chamber

wall and the flange of a fuel pipe because the components are normally formed from different densities (low and high) polyethylene and such a bonding would not result in a good seal (§7).

Thus, all of the Declarations previously submitted point to the fact that those skilled in the art, even those of the highest skill in the art, would not be led by the teachings of the cited art to the invention as now claimed and, in fact, they teach away from it.

General skepticism of those in the art is relevant as persuasive evidence of non-obviousness. While teaching away is a more pointed and probative form of skepticism expressed in the prior art, either teaching away or skepticism gives insight into the question of obviousness. Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 45 USPQ.2d 1977 (Fed. Cir. 1998). Therefore, the courts have held that skepticism about the merits of an invention or about whether it will solve the problem is important evidence of non-obviousness. In fact, doing what those skilled in the art suggests should not be done, is a fact strongly probative of non-obviousness. Kloster Speedsteel AB v. Crucible, Inc., 230 USPQ 81 (Fed. Cir. 1986).

As evidenced above and in the declarations, there were widely held prejudices and misconceptions within the industry. Even Rowe expresses such skepticism and, in fact, teaches away from such a design and method as claimed.

Furthermore, the present invention produced unexpected results. Unexpected results are strong support for non-obviousness as that which would have been

surprising to a person of ordinary skill in a particular art would not have been obvious. In re Soni, 34 USPQ.2d 1684 (Fed. Cir. 1995). Insight that is contrary to the understanding and expectations of the art points to patentability. Schenk A.G. v. Norton Corp., 218 USPQ 698 (Fed. Cir. 1983). Moreover, proceeding contrary to accepted wisdom of the art is strong evidence of non-obviousness. In re Hedges, 228 USPQ 685 (Fed. Cir. 1986).

Therefore, in view of the above, Applicant respectfully submits that the present invention is not obvious in light of the teachings of the prior art as supported by the prior art itself and the declarations previously submitted.

Indeed, the article or product claims which are directed to the specific fitting, subterranean fuel tank, and fuel pipe as defined by Claims 22-23, 25-31, 38-39, 54-57 and 61-63 are neither disclosed nor suggested by the teachings of Rowe in view of Evans, as Rowe, in fact, teaches against rigidly welding the fitting to the chamber wall. Furthermore, Carlesimo which relates to an underground sewer installation does not relate to the present invention.

Moreover, the prior art clearly does not suggest the inventive method as defined by Claims 32, 34-37, and 58-60. Assuming arguendo, that the aforesaid article or product claims are not patentable (the position taken by the Examiner), such a finding does not prevent a subsequent inventor from obtaining a patent on a new method of using the product where the new method is useful and non-obvious. Catalina Mktg. Int'l Inc. v. Coolsavings.Com Inc., 62 USPQ.2d 1781 (Fed. Cir. 2002). Thus, even if

a product or article is old, a process using it in a new and unobvious way may be patentable. Loctite Corp. v. UltraSeal Ltd., 228 USPQ 90 (Fed. Cir. 1985). Therefore, the question is whether the claimed method would have been obvious; it is not pertinent whether the product claims that are the subject of the use are themselves known or new or unobvious. The real question is whether the newly discovered utility would have been obvious. Id.

The method claims were previously limited to use in a petroleum forecourt installation for use in the petroleum industry. Even though the technique of fusion welding was known, there was no suggestion to apply such a technique to the method of forming a seal between an opening in a generally upright and planar subterranean chamber wall and a pipe passing through the opening in a petroleum forecourt installation in the petroleum industry, as presently claimed. Clearly, the method of this invention specifically requires the step of applying such a fitting to a petroleum forecourt installation in the petroleum industry (Step a) and applying energy transfer means to seal the fitting to the chamber (Step b) in a petroleum forecourt installation in the petroleum industry. Nowhere is this suggested in any of the art cited by the Examiner. Therefore, although Applicant respectfully submits that all of the claims in the application are patentable, the evidence in support of the unobviousness of the method claims as set forth in the aforementioned declarations is overwhelming.

Furthermore, others in the petroleum industry are now copying the present invention. Copying is evidence of non-obviousness of a patented design, Avia Group

Int'l Inc. v. L.A. Gear Calif. Inc., 7 USPQ.2d 1548 (Fed. Cir. 1988), as appreciation by contemporaries skilled in the field of the invention is a useful indicator of whether the invention would have been obvious to such persons at the time it was made. Vulcan Eng'g Co. v. FATA Alum. Inc., 61 USPQ.2d 1545 (Fed. Cir. 2002). Applicant is willing to supply a Declaration regarding such copying, at a later time if requested by the Examiner.

Moreover, the present invention has achieved tremendous commercial success. Commercial success must be considered before a conclusion on obviousness is reached. Lindemann Maschinenfabrik v. American Hoist & Derrick Co., 221 USPQ 481, 488 (Fed. Cir. 1984). Commercial success is relevant because the law presumes an idea would successfully have been brought to market sooner, in response to market forces, had the idea been obvious to a person skilled in the art. Merck & Co. v. Teva Pharm. USA Inc., 73 USPQ.2d 1641, 1651 (Fed. Cir. 2005). There is no doubt that a strong showing of commercial success, attributable to the merits of the claimed invention, is powerful and persuasive evidence of non-obviousness. Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 56 USPQ.2d 1456, 1464 (Fed. Cir. 2000). Similarly, Applicant is willing to provide a Declaration regarding its commercial success at a later time, if requested by the Examiner.

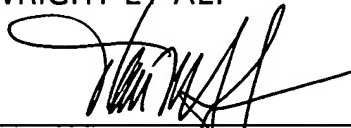
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For the reasons above, it is respectfully submitted that the claims are patentably distinguishable over the references cited by the Examiner and reconsideration and withdrawal of the rejection and allowance of the claims at an early date is earnestly solicited.

Respectfully submitted,

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